

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES



#19
N.C.H.
6-299

In re the Application of

Sven KORNFÄLT et al

On Appeal from Group Art Unit 1732

Serial No.: 08/817,391

Examiner: K. Jones

Filed: April 25, 1997

For: PROCESS FOR THE PRODUCTION OF A FLOOR STRIP

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GROUP 1700

REPLY BRIEF

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1. INTRODUCTION

This Reply Brief is filed pursuant to 37 C.F.R. 1.193(b)(1).

Appellants appreciate the Examiner's withdrawal of the rejection of claim 7 under 35 U.S.C. 103(a) as being unpatentable over Munk et al (U.S. Patent No. 4,594,347).

However, in the alternative rejection of claims 3-4 and 6-14 under 35 U.S.C. 103(a) as being unpatentable over Munk et al in view of Lindgren et al (U.S. Patent No. 4,940,503), the Examiner takes issue with appellants' analysis of the teachings of the prior art reference.

Specifically, in the Examiner's "Response to Argument" (beginning at page 7 of the Examiner's Answer), wherein Appellants pointed out that Lindgren et al "in no way contemplated the manufacture of flooring strips having a high abrasion resistance or any profiled shape in which a laminate is postformed on a carrier both on the top thereof and on the long sides thereof as claimed," the Examiner has mischaracterized Appellants' comments as "quite mis-leading (sic)."

While the Examiner has reproduced the teachings of Lindgren et al at column 1, lines 10-37, including underlining (See, top of page 8 of Examiner's Answer) as producing a "flooring material" and "floors," the present invention is neither directed to flooring materials nor is it a floor and, thus, may be considered to be nonanalogous to the claimed subject matter. Rather, it is specifically directed to a "floor strip," such as a dilation profile, a transition profile or a finishing profile, preferably for use with the flooring material or floors of the Lindgren et al patent.

The present assignee is the assignee of the Lindgren et al patent and is the manufacture of the flooring material sold in this country under the "PERGO" trademark and well knows the difference between flooring material and floor strips.

If the Board will direct their attention to the third paragraph of the instant application, it is clear that the present invention is directed to satisfying the "strong desire to bring about a floor strip with the same pattern as on a floor of thermosetting laminate." A floor of thermosetting laminate is the teaching of the Lindgren et al patent cited in the rejection, but there is nothing in Lindgren et al that would have led one skilled in the art to make floor strips.

Thus, Appellants stand by the statements in the opening Brief that the Lindgren et al reference "in no way contemplated the manufacture of flooring strips having a high abrasion resistance nor any profiled shape in which a laminate is postformed on a carrier both on the top thereof and on the long sides thereof as claimed" and take umbrage at the Examiner's allegations that Appellants have attempted to mislead this Board.

The profiles of the present invention cannot be characterized as "flooring material," that is, a material covering a floor or be characterized as a "floor." The Examiner here, by introducing the term "flooring applications," a term which cannot be found in Lindgren et al, is merely trying to find support for the existence of a non-existent disclosure.

Similarly, the Examiner, in his comments on the limitations of claim 8, now "submits that every particle board or fiber board is water resistance to some extent."

Appellants remind the Board that the Examiner's "naked comment" does not rise to the level of "prior art" required for rejection under 35 USC § 102/103. It should be noted by the Board that the Examiner is charged with the responsibility of making a thorough study and thorough investigation of the "available prior art" relating to the subject of the claimed invention; See, 37 C.F.R. 1.104(a)(1). To the extent that the Examiner has satisfied his duty under the Patent Rules, he has not cited any "prior art" to teach the recited limitation.

While Appellants agree that the disclosure of the prior art, i.e. the cited Munk et al reference, includes the drawings therein, drawings Figs. 3 and 4 of Munk et al do not show the limitations of "gluing" a thermosetting laminate of postforming quality in one piece on an upper side and on two long sides of the carrier via rounded-off edges as recited in independent claim 7. If, as the Examiner surmises, that a "floor" is the surface of a room upon which one stands, the Examiner still has not explained what would have motivated one skilled in the art to postform the laminate not only on the upper surface of a substrate, but also on two long sides of that substrate since such sides could not operate as a "floor," i.e. one cannot stand on the sides of such a material. The Examiner's machinations in attempting to "read" the teachings of the prior art on the claimed invention demonstrate the complete lack of the existence of a *prima facie* case of obviousness for the claimed invention.

2. CONCLUSION

Accordingly, the Board of Appeals is respectfully requested to reverse the Examiner's Final Rejection so that appellants may obtain the patent to which they are entitled.

A Request for Oral Hearing accompanies this Reply Brief.

Respectfully submitted,



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